

REMARKS

Claims 1-17 have been examined and have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Young et al., Pat. No. 6,669,564, in view of Pytlovany, Pat. No. 6,690,992.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2142. Section 2142 further states that “[t]he initial burden is on the examiner to provide some suggestion of desirability of doing what the inventor has done.”

Applicant respectfully traverses the §103(a) rejection as to claims 1 and 11 at least because one skilled in the art would not have been motivated to combine the Young and the Pytlovany references. The grounds of rejection fail to show where in the references is a suggestion or motivation to do so. *In re Mills* 916 F.2d 680, 682 (Fed. Cir. 1990).

Instead, the Examiner states that the motivation to combine the references stems from a need to “incorporate a search engine, taught by Pytlovany, into the gaming system, taught by Young, in order to quickly find additional gaming data.” Even assuming that the combination of the Pytlovany search engine with the Young gaming system may result in this feature, there is no

motivation to combine the references. If the two references were combined, the likely result would be a search engine that searches for the initial game file, and downloads the file. However, the Young reference discloses the placement of future gaming content in the same place, and then using a clue communicated to the user to assist him or her in being able to open the gaming content. One practicing this technology would not need to include a search engine to assist in locating the gaming content, as all future gaming content would be located in a place previously disclosed to the user. The Young reference would thus teach away from adding a necessary search engine. The addition of the search engine from the Pytlovany reference the rejection appears to be the use of improper hindsight to reconstruct the present invention using Applicant's disclosure as a roadmap. MPEP §2143 (see also *In re Vaeck*, 20 USPQ 1438 (Fed. Cir. 1991)).

Additionally, Applicant respectfully traverses the Examiner's rejection because the cited references fail to disclose all of the elements of claims 1 and 11. For example, claim 1 comprises a content management section adapted to set an address of which users are not notified in one or more content providing servers each in which a relevant program is placed. The relevant program is used to further advance the game, and a search mean searches for the address of the content providing server containing the relevant program. However, the Young reference, while using a content server, maintains the assets (different multimedia content objects, i.e. e-mail or video clips) for retrieval and delivery to game users, which are not part of the further game data. As noted above the Young reference notifies the users of the location of further game data, and requires the user to accomplish certain tasks before the levels may be accessed. The content

section of claim 1 creates network addresses where relevant programs are located, which are then not given to users. In an illustrative, non-limiting embodiment, the user then uses clues, found within the game itself, in a search engine to find the location of the additional game data. Thus, the cited references do not teach all of the elements of claims 1 and 11, making claims 1 and 11 allowable as written.

Claims 2-10 are allowable at least from their dependency on claim 1, while claims 12-17 are allowable due to their dependency on claim 11.

Applicant has added new claims 18-23 in order to further address the aspects of the invention. Claims 18 -21 are allowable at least based on their dependency on claim 1 or 11. Also, claim 22 is patentable because the references do not suggest a search engine that searches for content based on a plurality of clues. Finally, claim 23 is patentable at least by virtue of its dependency on claim 22.

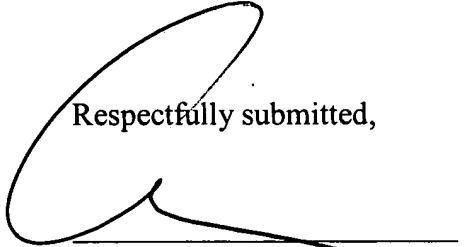
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 10/015,684

Attorney Docket No. Q67641

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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